

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q76655

Daisuke SUZUKI, et al.

Appln. No.: 10/623,568

Group Art Unit: 2629

Confirmation No.: 6560

Examiner: Seokyun MOON

Filed: July 22, 2003

For: INPUTTING DEVICE AND MOBILE TERMINAL

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated October 20, 2008. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-49 are pending in the present application. Claims 1, 9/1, 10/9/1, 12/1, 18/1, 19/1, 20/1, 21/1, 22, 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 stand finally rejected and are the subject of this Appeal. Claims 5-8, 9/5, 11/5-21/5, 30-39 and 40/30-49/30 are allowed and claims 11/1, 13/1-16/1, 23/22, 25/22, 26/22, 28/22, 42/22 and 44/22 are objected to but would be allowed if rewritten in independent form.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Claim 1 is rejected under § 102(b) as being anticipated by Ikehara (US 6,400,353).
- (2) Claims 12/1, 19/1 and 21/1 stand rejected under §103(a) as being unpatentable over Ikehara.
- (3) Claims 9/1, 10/9/1, 18/1, 20/1, 22, 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 stand rejected under § 103(a) as being unpatentable over Ikehara in view of Takatsuka (US 2004/0080491).

ARGUMENT

Appellants submit the present rejections are in error for the additional reasons set forth below.

(1) Whether claim 1 is patentable under § 102(b) as being anticipated by Ikehara (US 6,400,353).

As set forth in the Examiner's Answer, the Examiner contends the recited "sliding key" is disclosed by a combination of Ikehara's operating portion 8, operation electrode 10 and coupling pin 15a. (*Examiner's Answer*, p.4).

In the Response to Arguments, the Examiner contends the coupling pin 15a may be construed as part of a sliding key. However, Appellants submit the Examiner's contention is unreasonable. In fact, the Examiner even concedes that this coupling pin 15a is detached from the operation electrode 10 and operation portion 8.

Additionally, the Examiner contends that *Larson* 144 USPQ 347, 340 (CCPA 1965) holds that referring to a combination of two parts as a single part does not qualify as patentable subject matter. In response, Appellants continue to submit that *Larson*, in no way, supports the Examiner's position that coupling pin 15a is part of the operation portion 8 and operation electrode 10. Rather, *Larson* merely supports that merely making integral, separate components which are rigidly secured together, is an obvious design choice. However, because Ikehara discloses a gap between the coupling pin 15a and the operation electrode 10, Appellants submit *Larson* provides no guidance with regard to separate components operation electrode 10 and coupling pin 15a..

Secondly, even if the operating portion 8, operation electrode 10 and coupling pin 15a could be construed as a sliding key, Appellants submit that because operating portion 8 and operation electrode 10 are not fixed to the elastic member 15, Ikehara fails to disclose “a sliding key that is fixed on the outside surface of said elastic sheet,” as recited in claim 1. Rather, Ikehara clearly shows that the operating portion 8 and operation electrode 10 are not fixed to the elastic member 15 at all. (*See* FIG. 3).

Thus, Appellants submit claim 1 is allowable for at least this reason.

(2) Whether claims 12/1, 19/1 and 21/1 are patentable under §103(a) as being unpatentable over Ikehara.

Claim 12/1, 19/1 and 21/1 stand rejected under §103(a) as being unpatentable over Ikehara.

In response to this rejection, Appellants submit that because the Examiner’s purported modifications of Ikehara in view of alleged obvious design choices fail to compensate for the above noted deficiencies of Ikehara as applied to claim 1 above, claims 12/1, 19/1 and 21/1 are submitted to be allowable, at least by virtue of their dependencies.

(3) Whether claims 9/1, 10/9/1, 18/1, 20/1, 22, 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 are patentable under § 103(a) as being unpatentable over Ikehara in view of Takatsuka (US 2004/0080491).

Claims 9/1, 10/9/1, 18/1, 20/1, 22, 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 stand rejected under § 103(a) as being unpatentable over Ikehara in view of Takatsuka (US 2004/0080491).

In response to this rejection, Appellants submit that because Takatsuka, either taken alone or in combination with Ikehara, fails to compensate for the above noted deficiencies of Ikehara as applied to claim 1, claims 9/1, 10/9/1, 18/1 and 20/1 are allowable, at least by virtue of their dependency.

Regarding independent claim 22, the Examiner references Ikehara as disclosing the recited “elastic sheet having an outside surface disposed in an inside surface of said cabinet” and “a sliding key that is fixed on the outside surface of said elastic sheet.” More specifically, the Examiner cross references the application of Ikehara to claim 1 (as described above) to support this position. However, Appellants submit that Ikehara fails to disclose these features for the same reasons set forth above with regard to claim 1. Moreover, Appellants submit that because Takatsuka, either taken alone or in combination with Ikehara, fails to compensate for these deficiencies of Ikehara, claim 22 is allowable because the Takatsuka / Ikehara combination fails to disclose either the “elastic sheet having an outside surface disposed in an inside surface of said cabinet” or the “sliding key that is fixed on the outside surface of said elastic sheet,” as recited in claim 22. Furthermore, Appellants submit claims 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 are allowable, at least by virtue of their dependency.

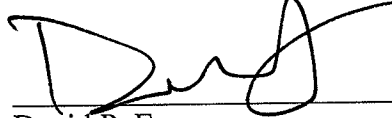
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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David P. Emery', written over a horizontal line.

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Date: December 18, 2008